

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: CILURZO et al.

EXAMINER: SUTTON, D.C.

SERIAL NO.: 10/577,408

ART UNIT: 1612

FILED: April 25, 2006

CONFIRM NO.: 1408

FOR: SELF-SUPPORTING FILMS FOR PHARMACEUTICAL AND FOOD USE

April 15, 2011

**PETITION UNDER 37 CFR 1.181 TO WITHDRAW FINALITY OF AN OFFICE
ACTION**

Mail Stop – Tech Center 1600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS

Applicants are in receipt of an Office Action mailed October 22, 2010, finally rejecting claims 1 – 5, 12 – 14, 16, 17 and 21 – 24 in this application. Applicants respectfully submit that the finality of the subject Office Action is premature and, therefore, petition for withdrawal of the final rejection, pursuant to Section 706.07(d) of the Manual of Patent Examining Procedure (MPEP).

Grounds

As grounds for this Request, Applicants state as follows:

The outstanding final Office Action rejects all the pending claims on new grounds.

Claim 16 has been rejected under 35 USC §112, 2nd paragraph, in view of the term “other excipients”. Claim 16 is as originally filed and published (see US 2009/0017085 A1), thus the wording could have been rejected in an earlier Office Action, but was not.

Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office action is proper, providing that:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicants submit that the rejection of claim 16 is a new ground of rejection. Also, because Applicant neither amended claim 16 nor filed an IDS between the subject non-final and final Office actions, the conditions required by MPEP § 706.07(a) cannot yet be satisfied.

Thus, for at least this reason, as well as the interests of fairness, the finality of the final Office Action should be withdrawn.

Currently pending claim 1 was amended in Applicant's last response of August 9, 2010 by incorporating the features of the previously presented Claim 15, which was cancelled. In the outstanding final Office Action, the Examiner raised new grounds of rejection under 35 USC §103(a), based on two prior art documents which were never cited before, i.e. Barkalow et al., and Chen et al.

Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office action is proper, as set forth above.

Applicants submit that because the features added to independent claim 1 were presented for examination in the preceding Office Action, the new grounds of rejection of claim 1 made in the final Office Action cannot reasonably be said to be either necessitated by a claim amendment or an Information Disclosure Statement.

The same applies consequently for dependent **claims 4-5, 12-13, and 16-17**.

Claims 2 and 3 are as originally filed and published (see US 2009/0017085 A1). However, the Examiner raised new grounds of rejection under 35 USC §103(a), based on three prior art documents, i.e. Barkalow et al., and Chen et al. (never cited before), in view of Zych et al., which was not cited by the Examiner in the earlier non-final Office Action, even if listed in the Information Disclosure Statement, filed by Applicants well before said earlier non-final Office Action.

Accordingly, also in this case, Applicants submit that because the features of claims 2-3 were presented for examination in the preceding Office Action, the new grounds of rejection of claims 2-3 made in the final Office Action cannot reasonably be said to be either necessitated by a claim amendment or an Information Disclosure Statement.

What is discussed above with respect to claim 1, applies even more so with respect to claim 14 and **claims 21-24**, that are directly or indirectly dependent upon claim

1 and involve the same subject matter as originally filed and published (see US 2009/0017085 A1). As a matter of fact, the Examiner raised new grounds of rejection under 35 USC §103(a), based on said two prior art documents which were never cited before, i.e., Barkalow et al., and Chen et al. against claim 14, and new grounds of rejection under 35 USC §103(a), based on three prior art documents which were never cited before, i.e., Barkalow et al., Chen et al. and Kasper et al. against claims 21-24.

Accordingly, also in this case, Applicants submit that because the features of claim 14 and claims 21-24 were presented for examination in the preceding Office Action, the new grounds of rejection of claim 14 and claims 21-24 made in the final Office Action cannot reasonably be said to be either necessitated by a claim amendment or an Information Disclosure Statement.

Conclusions

The conditions set forth in § 706.07(a) of the MPEP have not been satisfied. Accordingly, for that reason alone, as well as the interests of fairness, Applicants /Petitioner respectfully submit that the finality of the Office Action of October 22, 2010 should be withdrawn.

Please charge the Petition Fee, as well as any other fees which may be due to our Deposit Account No. 01-0035.

Respectfully submitted,

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